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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Marcus Haley

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MICHAEL CHAN

NCR CORPORATION

1700 SOUTH PATTERSON BLVD

DAYTON, OH 45479-0001

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

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MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/848,003	Applicant(s) HALEY ET AL.	
	Examiner Ella Colbert	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35 and 43-47 is/are pending in the application.
- 4a) Of the above claim(s) 35 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 35 and 43-47 are pending. Group II, claims 44-47 have been elected and claims 35 and 43 have been withdrawn without traverse in response to the Election/Restriction filed 8/11/08. Claims 44-47 will be examined.

Claim Objections

Claim 44 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 47. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). It is suggested that claim 47 become a system or an apparatus claim with the structure of a system or apparatus claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The recitation of "a unique transaction program identifier" was not found in the specification or in the drawings. The Applicants' are respectfully requested to point out where this recitation is found in the specification..

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 45 recites “a unique transmission program identifier” and claim 46 recites “a unique transaction program identifier”. It is unclear and vague whether the “unique transaction program identifier” in claim 45 is the same “unique transaction program identifier” as in claim 46 or a different “unique transaction program identifier”? If the “unique transaction program identifier” is the same as the second “unique transaction program identifier” this should be referenced as “the unique transaction program identifier” in claim 46.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,841,118) East et al, hereafter East in view of (US 7,412,223) Yamamoto et al, hereafter Yamamoto.

Claim 44. East discloses, A method of operating an automated teller machine (ATM), the method comprising: receiving from a portable device carded by an ATM customer a request to conduct an ATM transaction at the ATM (col. 1, line 46-col. 2, line 43 and col. 4, lines 1-9); examining the transaction authorization message which has been received from the portable device carried by the ATM customer to determine if the transaction authorization message is valid (col. 4, line 56-col. 5, line 4) and Yamamoto also discloses this claim limitation in Fig.'s 10A-10K); and executing the requested ATM transaction without obtaining any additional authorization message from an authorization center of a financial institution when the transaction authorization message received from the portable device carried by the ATM customer is determined to be valid (col. 5, lines 16-31).

East failed to disclose, receiving from the portable device carded by the ATM customer a transaction authorization message which is associated with the requested ATM and which the ATM customer has obtained from an authorization center of a financial institution before making the requested ATM transaction at the ATM. Yamamoto disclosed, receiving from the portable device carded by the ATM customer a transaction authorization message which is associated with the requested ATM and which the ATM customer has obtained from an authorization center of a financial institution before making the requested ATM transaction at the ATM (col. 8, lines 12-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Yamamoto in East because such an incorporation would allow East to have a mobile communication system that has a display screen for mobile

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banking and performing electronic mail and using the Internet for banking service.

Claim 45. East discloses, A method according to claim 44, further comprising:
receiving from the portable device carried by the ATM customer a unique transaction program identifier which is associated with the requested ATM transaction (col. 4, line 59-col. 5, line 4).

Claim 46. East discloses, A method according to claim 45, wherein examining the transaction authorization message includes: comparing a unique transaction program identifier contained in the transaction authorization message with the unique transaction program identifier received from the portable device carried by the ATM customer (col. 4, line 10-col. 5, line 31). East and Yamamoto failed to disclose, determining that the transaction authorization message is valid when the unique transaction program identifiers match; and determining that the transaction authorization message is invalid when the unique transaction program identifiers are unmatched. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine that the transaction authorization message is valid when the unique transaction identifiers match and to determine that the transaction authorization message is invalid when the unique transaction identifiers are unmatched because if the unique transaction identifiers (PIN) matches what is input into the machine or the device the transaction can be authorized but if the unique transaction identifiers (PIN) does not match what is input into the machine or device the transaction cannot be authorized and will be declined.

Claim 47. East discloses, A method of operating an automated teller machine (ATM),

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the method comprising: receiving from a portable device carried by an ATM customer a request to conduct an ATM transaction at the ATM (col. 1, line 46-col. 2, line 43 and col. 4, lines 1-9). East failed to disclose, receiving from the portable device carried by the ATM customer a transaction authorization message which is associated with the requested ATM transaction and which the ATM customer has obtained from an authorization center of a financial institution before making the requested ATM transaction at the ATM. Yamamoto discloses, receiving from the portable device carried by the ATM customer a transaction authorization message which is associated with the requested ATM transaction and which the ATM customer has obtained from an authorization center of a financial institution before making the requested ATM transaction at the ATM (col. 8, lines 12-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Yamamoto in East because such an incorporation would allow East to have a mobile communication system that has a display screen for mobile banking and performing electronic mail and using the Internet for banking service.

East discloses, examining the transaction authorization message which has been received from the portable device carried by the ATM customer to determine if a unique transaction program identifier contained in the transaction authorization message has been modified (col. 4, line 56-col. 5, line 4 and Yamamoto also discloses this in Fig's 10A-10K); and executing the requested ATM transaction without obtaining any additional transaction authorization message from an authorization center of a financial institution only when a determination is made that the unique transaction program

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identifier contained in the transaction authorization message has not been modified (col. 4, line 10-col. 5, line 31).

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

October 26, 2008